

REMARKS/ARGUMENTS

The Office Action mailed October 12, 2005 has been carefully reviewed. Reconsideration of this application, as amended and in view of the following remarks, is respectfully requested. The application originally contained claims 1-30. Claims 21, 22, and 25-30 have been cancelled. The claims presented for examination are: claims 1-20, 23, and 24.

35 USC 103 Rejection

In numbered paragraph 4 of the Office Action mailed October 12, 2005, claims 1-20, 23, and 24 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over:

the primary OraCon reference (Oracle® Applications, Concepts, Release 11i, May 2000, Oracle Corporation) in view of

the secondary OraEng reference (Oracle® Engineering User Guide Release 11i, January 2000, Oracle®);

the tertiary OraHR reference (Using Oracle® US Federal HRMS – The Fundamentals, Release 11i, January 2000, Oracle®); and

the quaternary OraPO reference (Oracle® Purchasing User's Guide, Release 11i, January 2000, Oracle®).

Applicants' Response to 35 USC 103 Rejection

Applicants have amended independent claims 1 and 16 presented for examination; therefore independent claims 1 and 16 and dependent claims 2-15, 17-20, 23, and 24 that depend from independent claims 1 and 16 are now presented in amended form. Since claims 1-20, 23, and 24 now appear in amended form the 35 USC §103(a) rejection in the Office Action mailed October 12, 2005 no longer applies.

Applicants believe that amended claims 1-20, 23, and 24 are patentable and that the OraCon, OraEng, OraHR, and OraPO references would not support a 35 USC §103(a) rejection.

Applicants have amended claims 1-20, 23, and 24 to change the preamble from a “comprising” preamble to a “consisting of” preamble.

A “comprising” preamble is what is known as an open term. In effect, comprising is a shorthand way of saying “including the following elements but not excluding others.” For example, a combination “comprising A + B” covers the combination A + B + C.

On the other hand, a “consisting of” preamble is a closed term. A combination “consisting of A + B” does not cover the combination A + B + C.

Applicants’ invention defined by amended claims 1-20, 23, and 24 provides a specific combination of elements “consisting of” the specific combination of elements enumerated in amended claims 1-20, 23, and 24. This specific combination of elements is not found in the cited references; therefore, the cited references would not support a 35 USC §103(a) rejection.

The primary OraCon reference both (1) fails to include a number of the elements of Applicants’ amended claims 1-20, 23, and 24 and (2) includes many elements in addition to the specific combination of elements of Applicants’ amended claims 1-20, 23, and 24. Similarly, the secondary OraEng reference, the tertiary OraHR reference, and the quaternary OraPO reference (1) fail to include a number of the elements of Applicants’ amended claims 1-20, 23, and 24 and (2) include many elements in addition to the specific combination of elements of Applicants’ amended claims 1-20, 23, and 24. The primary OraCon reference, the secondary OraEng reference, the tertiary OraHR reference, and the quaternary OraPO reference would not support a 35 USC §103(a) rejection.

There is no combination of the primary OraCon reference, the secondary OraEng reference, the tertiary OraHR reference, and the quaternary OraPO reference that would produce the specific combination of elements of Applicants' amended claims 1-20, 23, and 24. Further, there is no teaching of combining the primary OraCon reference, the secondary OraEng reference, the tertiary OraHR reference, and the quaternary OraPO reference to meet Applicants' amended claims 1-20, 23, and 24 now presented for examination.

Under MPEP §2142, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. It should be noted that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Since there is no suggestion or motivation to combine the references to produce Applicant's invention, a 35 U. S. C §103(a) rejection of Applicant's claims would not be appropriate.

SUMMARY

The undersigned respectfully submits that, in view of the foregoing amendments and the foregoing remarks, the rejections of the claims raised in the Office Action dated October 12, 2005 have been fully addressed and overcome, and the present application is believed to be in condition for allowance. It is respectfully requested that this application be reconsidered, that the claims be allowed, and that this case be passed to issue. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to call the undersigned attorney at (925) 424-6897.

Respectfully submitted,



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